

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Tsuneyuki TSUJI, et al.

Serial No. 09/964,637

Group Art Unit: 2145

Confirmation No. 1976

Filed: September 28, 2001

Examiner: Patrice L. Winder

For: INFORMATION BROWSE SUPPORTING METHOD AND INFORMATION BROWSE
SUPPORTING SYSTEM AND PROGRAM

APPELLANTS' BRIEF IN REPLY UNDER 37 C.F.R. § 41.41

Mail Stop - Appeal Brief - Patents

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed March 24, 2008 in the above-identified application, Appellants submit this Reply Brief having a response due date of May 27, 2008, since May 24, 2008 is a Saturday, May 25, 2008 is a Sunday, and May 26, 2008 is a USPTO holiday.

Application Serial No. 09/964,637
Appellant's Reply Brief under 37 C.F.R. § 41.41 dated May 27, 2008
Reply to Examiner's Answer mailed March 24, 2008

The grounds of rejection listed in the Examiner's Answer at pages 3-7 are substantially similar to those that were listed in the final Office Action mailed February 15, 2007, and have been addressed already in the Appeal Brief.

The Examiner's Response to Appellant's argument starts on page 7 and continues to page 13. The following comments are directed thereto.

Ellis discusses a client-server electronic program guide that provides users with an opportunity to define expressions that are processed by the program guide server (see Ellis, Abstract). A program guide server provides program guide data, schedules reminders, schedules program recordings, and locks programs based on expressions defined by the user. The program guide server also generates viewing recommendations based on a user's viewing histories.

Cooper discusses informing a user on a network of a programs viewed by another user on the network (see Cooper, Abstract).

However, in claim 1 of the application, for example, describes "setting a condition ... for searching for information suited to a first user, as first search condition information" and "setting a condition ... for information suited to [a] second user, as a second search condition information". As a result, information is presented to a certain user by "searching ... for an information element with respect to [the] certain user in accordance with information derived from the first search condition information ... and ... from the second search condition information".

Neither Ellis nor Cooper teach or suggest the features of claim 1, for example, because both references describe presenting viewing recommendations based on programs that have been already viewed, rather than presenting information to a certain user by "searching ... for an information element with respect to [the] certain user in accordance with information derived from the first search condition information ... and ... from the second search condition information".

Independent claims 1, 6 and 8 are patentable over Ellis and Cooper for reasons discussed below.

First, the Examiner asserted in section 10 of the Examiner's Answer, at page 8, lines 3 and 8, that:

Ellis disclosed an interactive program guide that searches for programs based on two search conditions, the first condition is the desired genre, actor, title, etc. and the second search condition is a parental lock. Both conditions are met when programming choices are presented. Cooper disclosed [that] other users can modify a parental lock feature. Appellant's invention, as claimed, conducts a search based on a first and a second search condition.

Col. 18, lines 32-39 of Ellis states that a "program guide server 25 may parentally control programs based on user preference profiles". As such, Ellis cannot teach or suggest a "second search condition" when Ellis describes that a program guide presented to a user is the same for a parent or a child because the program guide is based on a Boolean or natural language expression (see Ellis, col. 18, lines 32-39). Therefore, Ellis is silent as to the two search conditions.

Second, the Examiner asserted in section 10 of the Examiner's Answer, at page 8, lines 14-21, that:

Ellis disclosed that the first search condition is the Boolean expression used to request desired programming in column 22, lines 35-49, the conditions are genre, title, actor, etc. (as rejected). Then, Ellis disclosed a second search condition is the parental lock feature. The second search condition ... is not set by the Boolean expression inputted [by] the first user. Because as Appellant admits a parent lock is set by a parent and the children are impacted, Ellis disclosed "setting a second search condition by a second user, i.e. a parent".

The parental lock feature in Ellis is not a second search condition because the program guide, described in Ellis, provides users with an opportunity to parentally control titles, programs, or channels using the Boolean or the natural language expression (see Ellis, col. 18, lines 32-34). Further, these expressions are defined by a user selecting the parental feature from the main menu (see Ellis, col. 18, lines 36-39). As a result, the program guide server parentally controls programs based on these selected features (see Ellis, col. 18, lines 34-36). Therefore, the Examiner's assertion that the Boolean expression constitutes a first condition and a parent lock constitutes a second condition is incorrect. Rather, Ellis describes using the Boolean expressions to define the parental control features, which are used to set locks for the child (e.g. first user).

Further, no matter how the Examiner interprets Ellis, the Boolean expression, the program settings, and the parental lock are conditions set by the parent for the child (e.g. the first user). As such, Ellis does not discuss a parent setting a lock for themselves, and, therefore, cannot qualify as a first or a second user. Therefore, the lock is being set for only one user (e.g. the child, who is the first user). In sum, no matter how one of ordinary skill in the art reads or

interprets Ellis, nowhere in Ellis is it described setting a second search condition for the second user, as required by claim 1.

Thus, in view of the foregoing, Ellis fails to teach or suggest "setting a [second search] condition ... for searching information suited to this second user", as required by claim 1, because Ellis is merely concerned with using the Boolean expression to request the desired programming, as well as, control the programming that is being viewed by the user.

Third, the Examiner asserted in section 10 of the Examiner's Answer, at page 9, lines 9-15, that

Appellant seems to understand that parental locks allow one member of a family, i.e. the parent, to control what another member of the family, i.e. a child, views. The claim portion recited requires that the second search condition be inputted by one user and impact another user. Ellis disclosed a first search condition and a second search condition, i.e. a parent lock. Cooper disclosed a written description of setting a parent lock condition, i.e. "inputted by any one among the plurality of user in a way that specifies a second user".

As previously stated, Ellis does not teach or suggest a second search condition. Further, the above-mentioned assertion by the Examiner is incorrect because the claim language recites "setting a condition, inputted by **any one among a plurality of users** in a way that specifies a second user". Therefore, the Examiner's assertion that one user inputs the second search condition in claim 1 is incorrect.

In addition, the parental lock feature in Ellis is not related to any aspect of claim 1 because the parental lock feature allows the parent to lock the system, e.g. to prevent unauthorized use by the child. Stated another way, Ellis describes that no information will be presented to a child when the child meets the search condition information inputted by the parent. However, claim 1 information is presented to a certain user when "searching ... for an information element with respect to [the] certain user in accordance with information derived from the first search condition information ... and ... from the second search condition information". Therefore, instead of "presenting to the certain user a piece of information corresponding to a searched result", e.g. information derived from the first search condition information and the second search condition information, Ellis describes that information will *not* be presented to a child when the piece of information corresponds to the search condition inputted by the parent.

Thus, not only does Ellis fail to teach or suggest a second search condition, but the parental lock feature in Ellis does not relate in any way to any of the features recited in claim 1.

Further, Cooper fails to teach or suggest the above-quoted feature because Cooper is merely concerned with enforcing parental controls set by the parent for different family members (see Cooper, col. 5, lines 63-65). Further, col. 6, lines 1-5 of Cooper describes that "a *parent* can configure the family member accounts such that a child has privilege only to see TV programs having a "G" rating. As such, in Cooper a condition is not "inputted by **any one** among a plurality of users in a way that specifies a second user" rather only the parent specifies what the family members (e.g. children) can view in the parental controls, not the children. Therefore, in Cooper not "any one among a plurality of users" can specify a condition that will apply to another person.

Thus, neither reference, taken alone or in combination, disclose "setting a [second search] condition, inputted by any one among the plurality of users in a way that specifies a second user, for searching information suited to this second user, as a second search condition information on this second user" as recited in claim 1, for example.

Fourth, the Examiner asserted in section 10 of the Examiner's Answer, at page 10, lines 4-5, that:

There are no "different users" in the presentation limitation only a first search condition and a second search condition".

However, the Examiner misconstrues the language recited in claim 1. When reading claim 1 in its entirety, one of ordinary skill in the art would clearly understand that the "first search condition" is "for searching information suited for a first user" and the "second condition" is "for searching information suited to this second user". As a result, in claim 1 "[information] presented to the certain user" corresponds to the searched information for different users (e.g. first and second). Therefore, the assertion by the Examiner that there are no "different users" is not correct.

Fifth, The Examiner asserted in section 10 of the Examiner's Answer, at page 10, lines 5-9, that:

The combination of Ellis-Cooper taught different user setting a first search condition and a second search condition. However, the claim recites that the presentation is to a single user "derived from" the first and second search conditions. Meaning the presentation does not have to display "information for different users".

As stated above, the Examiner's interpretation of the claim language is incorrect because claim 1 requires "searching ... for an information element with respect to a *certain user* in accordance with information derived from the first search condition ... and information derived from the second search condition ... and ... present[s] to the certain user a piece of information corresponding to [the] search[ing]." Stated another way, information presented to the certain user is based on the first search condition suited for the first user and the second search condition suited for the second user. Thus, the information presented to the certain user is based on the two search conditions for the two users.

As such, in light of the above, neither reference teaches or suggests at least the above-quoted features. Therefore, it is submitted that claims 1, 6 and 8 are patentable over the cited references.

Dependent claims 2 and 9 are patentable over Ellis and Cooper for the following reasons.

The Examiner asserted in section 10 of the Examiner's Answer, at page 11, lines 1-6, that:

The limitation a "presenting a piece of information indicating a setting user" is worded broader than Appellant's interpretation. "[A] piece of information", i.e. data is broad enough to mean Ellis' "locked tag" because the "piece of information" can be anything and "indicating" does not mean identifying. The "setting user" is represented by conditions set by a user, i.e. a parent and a who. The "piece of information" represents a "who" but doesn't have to identify that who".

It is submitted that the limitation quoted above is not worded broader than Appellant's interpretation. Primarily because "a piece of information" presented "indicat[es] a setting user" (e.g. the person who set the condition) as recited by claim 2, for example. According to dictionary.com, "indicate" means to point out, direct attention to (see <http://dictionary.reference.com/browse/indicating>). In this case, the recitation in claim 2 "piece of information" points out "who" set the condition. Therefore, "locked tag" as described in Ellis, cannot constitute a "piece of information". Thus, in view of the foregoing, claims 2 and 9 are patentable over the cited reference.

Dependent claim 3 patentable over Ellis and Cooper for the following reasons.

The Examiner asserted in section 10 of the Examiner's Answer, at page 11, lines 9-14, that:

According to Ellis, the first search condition is the Boolean expression that represents a user's desired program, column 22, lines 35-49. In Ellis, the second search condition is a parental lock feature. When the search results are displayed, those results with a "locked tag" are results where the desired programming resulting from the first search condition matched the undesired programming of the second search condition.

In Ellis, the program guide provides users with an opportunity to define an expression, i.e. attribute types, attributes and logical operators (see Ellis, col. 22, lines 35-40). The defined expression is provided to the program guide server for processing (see Ellis, col. 22, lines 41-45). The program guide server processes the defined expression and returns the result to the client or performs the guide function (see Ellis, col. 22, lines 49-71).

Nowhere do the cited portions of Ellis teach or suggest "searching, based on the second search condition information set by the certain user ... for an information element suited to this second user and checking whether ... the ... searched information element is searched by the first search condition information" as required by claim 3, rather Ellis is merely concerned with a client providing a condition to the server and the server returning a result back to the client or performing the desired function.

Dependent claims 5 and 12 are patentable over Ellis and Cooper for the following reasons.

The Examiner asserted in section 10 of the Examiner's Answer, at page 11, lines 17-20, that:

Appellant does not specifically argue what is missing. One feature of the claimed limitation is "inputting" "natural language". The passage that was recited in the rejection and Appellant admits on page 14, indicates that the parental lock feature, i.e., the second search condition, may be input as "natural language".

Examiner's assertion is incorrect because the passage, e.g. col. 18, lines 32-39 of Ellis, which was recited in the rejection and in the Appeal Brief describes that the program guide provides users with an opportunity to parentally control titles, programs, or channels using Boolean or natural language expressions. However, this description in Ellis fails to disclose or suggest "generating the second search condition information **by analyzing natural language inputted** in such a way that ... specifies the second user" as required by claim 5. The program guide, described in Ellis, provides a user with an *opportunity to parentally control titles, programs, or channels* but does not describe generating the second search condition information *by analyzing natural language inputted* in such a way that ... *specifies the second user*. Therefore, in light of

the foregoing, Ellis fails to disclose or suggest any feature with specifying the second user as recited in claims 5 and 12.

Dependent claim 16 is patentable over Ellis and Cooper for the following reasons.

The Examiner asserted in section 10 of the Examiner's Answer, at page 12, lines 3-6, that:

Ellis taught using Boolean search expressions which are composed of "keywords". The results from searching using the Boolean search expressions are hits. The "hits" in Ellis' invention are program titles that match the keywords. Ellis clearly teaches providing programming list, thus, Ellis taught "hit key word counts".

In Ellis, column 13, lines 3-16 describes that a user enters a search criteria and a program guide client will request the program guide server to perform the search. However, nothing was found in col. 13, lines 3-16 of Ellis, that teaches or suggests "determin[ing] a *recommendation degree* corresponding to a *hit keyword count* with respect to ... [the] searched using the first search condition and the second search condition". As previously mentioned, Ellis cannot teach or suggest this feature because Ellis does not teach or suggest using a second search condition and, therefore, Ellis cannot "determine a recommendation degree corresponding to a hit keyword count" as required by claim 16.

Dependent claim 17 is patentable over Ellis and Cooper for the following reasons.

The Examiner asserted in section 10 of the Examiner's Answer, at page 12, lines 9-11, that:

Appellant claim does not require that both "tables" because the claim language recites "or". Ellis taught a favorites table with "preference attributes" which are stored and are consulted to recommend programming.

In Ellis, column 20, lines 24-31 describes that the program guide server or program guide client may filter viewing recommendations based on similar expressions, profiles, and/or viewing histories. Further, column 16, lines 34-44 of Ellis describes generating a profile listing based on preference levels set in the profile. However, neither cited portion of Ellis teaches or suggests that "a recommendation degree is derived using data from a *care-for-others information table* **and/or** a *favorite information table*" because Ellis is merely concerned with providing a listing or a recommended listing based on the profile rather than deriving a "recommendation degree ... using data from" either table or from both the tables, as required by claim 17. Further, Ellis fails to teach or suggest a "favorite information table" because Ellis is merely concerned with basing

Application Serial No. 09/964,637
Appellant's Reply Brief under 37 C.F.R. § 41.41 dated May 27, 2008
Reply to Examiner's Answer mailed March 24, 2008

recommendations on similar expressions, profiles, and/or viewing histories rather than a favorites table. Therefore, claim 17 is patentable over Ellis and Cooper.

Dependent claim 18 and 19 are patentable over Ellis and Cooper for the following reasons

The Examiner asserted in section 10 of the Examiner's Answer, at page 12, lines 14-20, that:

When Appellant considers Ellis, Appellant should consider in the context of the entire disclosure. From the rest of Ellis' disclosure, we know that Ellis taught recommending programs based on matches with attributes of a user's profile and viewing histories of other users, see column 15, lines 38-41 and column 19, lines 47-58.

According to column 15, lines 38-41 of Ellis, a user sets their preference profile to varying degrees of an active state (e.g. wide, moderate, or narrow scope). According to column 19, lines 47-48 of Ellis, the program guide processes the user's profile along with the viewer histories to present a more customized viewing experience to the user. For example, the program guide may identify which programs the user has watched and has not watched and indicate such episodes to the program guide client when the program guide client requests program listings. However, in claim 18 "a program having a *larger hit count* in the care-for-others information tables *takes a larger recommendation value*". This feature is not taught or suggested in Ellis because the cited portions of Ellis merely describe presenting to the user programs that the user has watch or has not watched rather than giving a "*larger recommendation degree value*" to a "programming having a larger hit keyword count" as required by claim 18.

Further, Ellis fails to teach or suggest **sorting** "information displayed in a program guide ... in [a] format corresponding to the recommendation degree of each item" as required by claim 19 because, as previously mentioned, Ellis is merely concerned with presenting programs that the users have or have not watched. Therefore, such a blanket statement does not teach or suggest how information is sorted. Thus, claims 18 and 19 are patentable over Ellis and Cooper.

Dependent claim 20 is patentable over Ellis and Cooper for the following reasons

The Examiner asserted in section 10 of the Examiner's Answer, at page 13, lines 5-8, that:

Appellant admits on page 15, that program guide server 25 receives information from chat groups. Chat groups communicate in the chat rooms through simple messages which are formatted like e-mail messages. Also ... Ellis' disclosure taught electronic messaging through the cable provider in column 10, lines 36-39.

On page 15 of the Appeal Brief, Appellant did not admit "program guide server 25 receives information from chat groups", rather Appellant indicated that column 12, lines 43-51 describes that a "program guide server may obtain, for example, ... chat group links" (see Appeal Brief, page 15). Further, the assertion by the Examiner that "chat groups communicate in the chat rooms through simple messages which are formatted like e-mail messages" correlates to receiving "electronic mail communications addressed to a logged-in user" is simply incorrect because these communications described in Ellis are not formatted like e-mail messages but rather are electronic messages. Therefore, these messages described in Ellis do not constitute "an electronic mail communication" as recited in claim 20.

The Examiner asserted in section 10 of the Examiner's Answer, at page 13, lines 9-13, that:

The care of information table was an alternative option. Appellants claims do not require both "tables" because the claim language recites "or". Ellis taught a favorites table with "preference attributes" which are stored and are consulted to recommend programming. Also see Ellis, column 20, lines 24-31. Therefore, Ellis uses "attributes" of a favorite table to make recommendations.

In Ellis, column 20, lines 24-31 is merely concerned with generating recommendations based on a user profile or viewing histories. However, Examiner's attention is respectfully directed to claim 20, lines 3-5, which recites "said control unit *reads* all keywords entered into the *favorite information table* ... **and** ... the *care-for-others information table* related to the logged-in user". As such, Ellis does not require reading both tables as is required in claim 20. Therefore, Ellis fails to teach or suggest the above-quoted feature recited in claim 20.

The Examiner asserted in section 10 of the Examiner's Answer, at page 13, lines 14-20, that:

The email messages received by the program guide 25 include content, such as the subject line or body, that information is considered like any other "attribute" to determine recommendations. According to Figure 20b, the recommendations have an email format.

It is submitted that a person having ordinary skill in the art would clearly understand when viewing Fig. 20b of Ellis, that the recommendation 2111 image does not have an email format but rather has a message format, non-email like. Further, column 20, lines 43-45 of Ellis does

Application Serial No. 09/964,637
Appellant's Reply Brief under 37 C.F.R. § 41.41 dated May 27, 2008
Reply to Examiner's Answer mailed March 24, 2008

not describe the recommendation 2111 image as an email format but rather describes the recommendation 2111 image as a viewing recommendation overlay. Stated another way, Fig. 20b describes that a recommendation image is placed over a display, whereas in claim 20 "the electronic **mail** communications" is displayed "according to a format corresponding to the recommendation degree for each item". Therefore, in view of the foregoing, Ellis fails to teach or suggest the features of claim 20.

Summary

For the reasons set forth above and in the Appeal Brief and the Amendments filed during prosecution of the application, it is submitted that claims patentably distinguish over the prior art cited in rejecting the claims. Thus, it is respectfully submitted that the Examiner's final rejection of the claims is without support and, therefore, erroneous. Accordingly, the Board of Patent Appeals and Interferences is respectfully urged to so find and to reverse the Examiner's final rejection.

Application Serial No. 09/964,637
Appellant's Reply Brief under 37 C.F.R. § 41.41 dated May 27, 2008
Reply to Examiner's Answer mailed March 24, 2008


CONTINGENT PETITION FOR EXTENSION OF TIME

Appellant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: May 27, 2008

By: 
Sheetal S. Patel
Registration No. 59,326

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501